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In re Application of:
SIMS, PETER J.
Serial No.: 09/020,393
Filed: February 09, 1998
For: Compositions and Methods to Inhibit
Formation of the C5B-9 Complex of Complement

DECISION ON PETITION

This is a decision on the petition, filed November 15, 1999, to withdraw the restriction requirement relative to claims 10-19. Note, the petition has been treated under the provisions of 37 CFR 1.144.

On February 4, 1999, a 32 way restriction requirement was mailed to applicant. On March 10, 1999, applicant elected Group II with antibodies as the species. This corresponded to claims 10-12 and 16-17. Along with the election, applicant traversed the restriction requirement at least insofar as it related to claims 10-19. On June 8, 1999, a non-final Office action on the merits was mailed to applicant. That Office action said that the traversal of the restriction requirement was not persuasive because the inventions were independent or distinct for the reasons set forth in the February 4, 1999 requirement. The restriction requirement was made final in the June 8, 1999 action. On November 15, 1999, the present petition was filed.

Petitioner argued that the June 8, 1999 Office action failed to respond to any of applicants' reasons why there are not 32 inventions and failed to explain why the divisions were not more appropriately divided into species rather than inventions. Petitioner then reiterated the position that all of claims 10-19 were directed to a single invention and, therefore, claims 10-19 should all be examined.

Restriction among invention is proper when the inventions are independent or distinct and there would be a serious burden on the examiner if all the inventions were examined in the same application. See MPEP 803. In the February 4, 1999 restriction requirement, the examiner fully explained how the inventions listed therein were independent or distinct from each other and why there would be a serious burden on the examiner if all the inventions were examined in the

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same application. However, petitioner failed to point out any real deficiency in the examiner's position as stated in the February 4, 1999 restriction requirement. Applicants' March 10, 1999 paper will be treated here in detail as the November 15, 1999 petition provided nothing more than what is already in that paper.

Page 1 through page 5, line 17, constituted a reiteration of the invention Groups as set forth by the examiner.

Page 5, line 18, through page 6, line 2, constituted a general statement that the restriction requirement is improper and that the examiner confused restriction and election of species. No supporting reasons for such a statement were given there.

At page 6, lines 2-14, applicants set forth what they believed to be a reasonable grouping for the claims.

At page 6, lines 15-16, applicants set forth the invention they elected for examination.

At page 6, line 17, through page 7, lines 1-5, applicants correctly stated that if the examiner maintained the restriction requirement, an obviousness-type double patenting rejection cannot later be made between the claims. See 35 U.S.C. 121.

At page 7, lines 6-13, applicants asserted that the examiner acknowledged that the independent claim, claim 10 in particular, was generic. Applicants went on to say that if a generic claim is allowable over the prior art, there can be no concern about the distinctness of various species encompassed by the generic claim (see 37 CFR 1.141). Applicants further stated that even if the species were patentably distinct, an allowable generic claim renders moot the effort to limit the application to a single invention defined by each species. While this may be true, a review of the record reveals that claim 10 has not been determined to be allowable over the prior art. Therefore, applicants' arguments are not persuasive of reversible error in the examiner's restriction requirement.

At page 7, lines 14-19, applicants asserted that restricting the claims into 32 inventions would incur substantial cost for applicants, which would place an undue burden on the assignees of this application. This argument is not persuasive since cost is not a factor in determining the correctness of a restriction requirement.


Page 7, line 20, was a final request to reconsider the restriction requirement and provide an action on claims 10-19.

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~~Page 8, which is the last page, merely stated that applicants petitioned the restriction requirement if the examiner maintained his position and provided miscellaneous statements regarding fees.~~

Since petitioner has failed to provide any persuasive reasons why the restriction requirement was in error, the petition is hereby denied.

PETITION DENIED.


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